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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,242	01/09/2004	Mark Robert	077196-0025	7772
1923 7590 03/17/2008 MCDERMOTT, WILL & EMERY LLP 227 WEST MONROE STREET SUITE 4400 CHICAGO, IL 60606-5096				
EXAMINER				
STULIL, VERA				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
03/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/754,242

Applicant(s)

ROBERT, MARK

Examiner

VERA STULII

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 31, 2007 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specification discloses presence of stabilizers in claimed invention. It was well known in the art that disclosed stabilizers provide emulsifying properties as well as stabilizing properties. Specification does not provide examples or guidance regarding a product without an emulsifier.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 10 recite absence of emulsifier and presence of stabilizer. Claims 7 and 16 recite carrageenan, guar gum, xanthan gum, cellulose and other hydrocolloids as examples of stabilizers. It was well known in the art that carrageenan, guar gum, xanthan gum, cellulose and other hydrocolloids provide emulsifying properties as well as stabilizing properties. Therefore elimination of emulsifiers conflicts with presence of stabilizers i.e. gums which may act as emulsifiers.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hussein (US 6,197,362) in view of Dairy Foods.

References and rejection are incorporated herein as cited in the previous Office Action.

Response to Arguments

The rejection of Claims 1-9 under 35 U.S.C. 102(b) as being anticipated by Hussein (US 6,197,362) has been withdrawn due to the recent amendment of claim 1.

Applicant's arguments filed December 31, 2007 have been fully considered but they are not persuasive.

On page 4 of the Reply to the office Action mailed August 22, 2007, Applicant states that Applicant respectfully requests withdrawal of the rejection of claims 1-18 under 35 U.S.C. 112, first paragraph, and the rejection of claims 10-18 under 35 U.S.C. 112, second paragraph, "in view of the fact that emulsifiers and stabilizers as two separate ingredients". On page 4 of the Reply Applicant also states that:

Applicant respectfully submits that emulsifiers and stabilizers are different ingredients, having different functions in the formulation of dairy products. For example, emulsifiers make it possible to uniformly disperse tiny particles of globules of one liquid into another. Stabilizers, on the other hand, aid in maintaining smooth texture and uniform color and flavor. See attached from Darigold webpage. On the web page, guar gum and carrageenan are listed under the "Stabilizer" section, not under the "Emulsifier" section. Therefore, these ingredients are clearly known stabilizers, supporting Applicant's assertion that stabilizers and emulsifiers should be considered separate ingredients when evaluating Applicant's invention in view of the cited references.

Examiner respectfully disagrees. As evidenced by HANDBOOK OF HYDROCOLLOIDS, some hydrocolloids (carrageenan, guar gum, xanthan gum,

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cellulose, gum arabic, tragacanth gum, karaya gum, konjac flour, and konjac mannan) function as both emulsifiers and stabilizers.

It is noted that examples presented in the Specification is not a part of claimed invention. As stated in the previous Office Actions, claims 1 and 10 recite absence of emulsifier and presence of stabilizer. In the same time, claims 7 and 16 recite carrageenan, guar gum, xanthan gum, cellulose and other hydrocolloids as examples of stabilizers. It was well known in the art that carrageenan, guar gum, xanthan gum, cellulose and other hydrocolloids provide emulsifying properties as well as stabilizing properties, and therefore were well known in the art emulsifiers. Therefore elimination of emulsifiers conflicts with presence of stabilizers i.e. gums which may act as emulsifiers. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for the reasons stated above and below and also for the reasons of record stated in the previous Office actions.

On page 5 and 7 of the Reply Applicant state that "The present invention is directed to a dairy-based pourable dessert topping without an emulsifier". Examiner respectfully disagrees for the reasons stated above and below and also for the reasons of record stated in the previous Office actions. Claims 7 and 16 recite carrageenan, guar gum, xanthan gum, cellulose and other hydrocolloids as examples of stabilizers. It was well known in the art that carrageenan, guar gum, xanthan gum, cellulose and other hydrocolloids provide emulsifying properties as well as stabilizing properties, and therefore were well known in the art emulsifiers.

On page 6 of the Reply Applicant state that "Applicant does not agree that stabilizers and emulsifiers perform the same functions". Applicants are referred to response to argument as stated above.

On pages 6 and 7 of the Reply Applicant state that combination of the cited references is improper, but even if proper, Applicants' invention is patentable over the combination of references. Examiner respectfully disagrees. In regard to claims 1 and 10, Hussein discloses pourable dessert liquid product comprising from about 2 weight % to about 20 weight % milk solids nonfat (Col. 1 lines 58-59), from about 4 weight % to about 35 weight % sweetener (Col.2 lines 4-5), from about 1 weight % to about 15 weight % of fat (Col.1 line 64-65), from about 0.01 weight % to about 2.0 weight % of stabilizer (Col.2 line 11-16), from about 0.1 weight % to about 2 weight % of flavoring agent (Col.2 lines 17-23).

In regard to claims 2 and 11, Hussein discloses that milk solids nonfat include dried skim milk, whey protein and milk protein concentrate (Col.1 line 58-59).

In regard to claims 3, 4, 12 and 13, Hussein discloses dairy fats, dairy crèmes, and the like (Col.2 lines 1-2).

In regard to claims 5 and 15, Hussein discloses sweeteners such as sucrose and corn syrup (Col.2 lines 7-10).

In regard to claims 6 and 14, Hussein discloses high fructose corn syrup, sucrose, dextrose, and corn syrup (Col. 2 lines 7-10).

In regard to claims 7 and 16, Hussein discloses stabilizers such as carrageenan, guar gum, locust bean gum, xanthan gum, cellulose, modified cellulose, hydrocolloids and the like (Col. 2 lines 11-16).

In regard to claims 8 and 17, Hussein teaches that the pourable dessert product may be incorporated into food products were condensed and/or evaporated milk is called for such as custards, creme brulee and the like (Col. 2 lines 35-37). It is also noted that Hussein teaches use of dairy crèmes (Col.2 lines 1-2) as a fat component for pourable dessert. Therefore the resulting product comprises combination of dairy crème, evaporated milk, and condensed milk, which makes it "tres leches" dairy mix.

In regard to claims 9 and 18, Hussein discloses soaking a suitable cake with an appropriate amount by weight of the pourable dessert liquid mix (Col.2 lines 49-50).

Claims 1 and 10 differ from teachings of Hussein in recitation of absence of emulsifier. Reference Dairy Foods ("New Heights in Emulsifier Technology – Elimination of Polysorbate 80 from Dairy Food Formulations") discloses elimination of emulsifiers such as Polysorbate 80 from dairy dessert compositions (ice cream, ice milk, frozen yogurt and sugar-free products). Dairy Foods discloses that polysorbate 80 possibly causes cancer (p. 1 § 2). Dairy Foods also disclose that a stabilizer/emulsifier blends have been developed that can eliminate polysorbate 80 from dairy food formulations, while maintaining or even improving finished product quality (p. 1 § 4). Dairy Foods also disclose that the new stabilizer/emulsifier blends replaced emulsifying system in a range of frozen dairy desserts, including traffic brand and premium ice cream, ice milk, frozen yogurt and sugar-free products (p. 1 § 5). Dairy Foods also disclose that

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ingredients such as "locust bean gum, cellulose gum, guar gum and carrageenan" are used in the new emulsifying blends. It was well known in the art that carrageenan, guar gum, xanthan gum, cellulose and other hydrocolloids provide emulsifying properties as well as stabilizing properties, and therefore were well known in the art emulsifiers and stabilizers at the same time. Since Hussein discloses use of ingredients such as carrageenan, guar gum, locust bean gum, etc. (Col. 2 lines 11-16), and Dairy Foods teaches use of locust bean gum, cellulose gum, guar gum and carrageenan in emulsifying blends, it would have been obvious to one skilled in the art to employ locust bean gum, cellulose gum, guar gum and carrageenan as an emulsifying blend in order to remove "chemically sounded" emulsifiers and still maintain or even improve finished products quality as taught by Dairy Foods.

On page 7 of the Reply Applicants state that "Further, both references appear to teach away from the formulation of the present invention because they both contain an emulsifier, while the present invention does not". Examiner respectfully disagrees for the reasons stated above. Further in this regard, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERA STULII whose telephone number is (571)272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VS

/Steve Weinstein/
Primary Examiner, Art Unit 1794